

**REMARKS**

Claims 1, 2 and 5-9 are all the claims pending in the application.

**I. Response to Objection to Specification and Rejection under 35 U.S.C. § 112**

In paragraph 2 of the Office Action, the Examiner has objected to the specification under 35 U.S.C. § 112, first paragraph, as allegedly failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear concise and exact terms as to enable any person skilled in the art to make and use the invention, substantially for reasons already of record.

In paragraph 3, claims 1, 2 and 5-9 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a non enabling disclosure.

Applicants respectfully traverse the rejection for the reasons of record, which are incorporated herein by reference. Namely, the fact that significantly different results are obtainable with only very small changes in density is not a basis for objecting the specification as non-enabling or as failing to contain an adequate written description. The Examiner has not appropriately considered that the Examples are based on measured results and can be reproduced based on the content of the disclosure. Moreover, the fact that marked changes in properties are observed due to only small changes in density in an art that the Examiner characterizes as “predictable” only further supports an argument of unexpected superiority. Thus, the Examiner’s assertion of this point is misplaced to the extent that the Examiner relies upon it to conclude that the specification is non-enabling or lacks adequate written description.

The extent to which the Examiner relies on the results of the Examples to assert the

disclosure is inconsistent is a separate issue. The fact that densities taught by Applicants may not produce the results of the same level of superiority as the presently claimed than  $0.919\text{g/cm}^3$ , does not render embodiments of other densities not “preferred,” much less not adequately described or non-enabled. Applicants are permitted to selectively claim embodiments described and enabled in the disclosure over the course of prosecution. There is no prohibition against doing so.

To satisfy the enablement requirement of section 112, an application must disclose the claimed invention in sufficient detail to enable a person of ordinary skill in the art to make and use the claimed invention. To satisfy the written description requirement of section 112, the description must show that the applicant was in possession of the claimed invention at the time of filing. Both of these statutory requirements are satisfied here. The PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately described or enabled by the description of the invention provided in the specification of the application; this includes, providing sufficient reasons for doubting any assertions in the specification. In this case, the Examiner has provided no cognizable bases to refute these two facts and therefore, the Examiner has not met his burden of providing a reasonable basis to question the description or enablement provided for the claimed invention.

Additionally, the Examiner must consider the totality of the evidence. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. See

MPEP § 2142 citing *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. When an Applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the Examiner must reconsider the patentability of the claimed invention and the decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the Examiner and the evidence submitted by the Applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion was reached, not against the conclusion itself. See MPEP § 2142 citing *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

In this case, the totality of the evidence as a whole is more convincing that the presently claimed invention is adequately described and sufficiently enabled than any arguments or evidence provided by the Examiner.

Accordingly, Applicants respectfully request withdrawal of the §112, 1<sup>st</sup> paragraph rejection.

## **II. Claim Rejections under 35 U.S.C. § 103(a)**

In paragraph 4, claims 1, 2 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishikawa et al.

The Examiner states that Applicants' submission of a Rule 132 Declaration from co-inventor Ukei is not seen as possessing a great deal of weight, both for the fact that he is a clearly interested party as well as the fact that the alleged very limited comparison of certain of the data found in the specification sets forth results that are not considered to be unexpected, and also ignores the "Example 2, Comparative Example 3" showing in the reference (beginning at Col 6, line 18) which appears to not use any filler. Regarding the data provided in the Declaration, the Examiner states that only a single data point is provided and that significant changes in the elongation at break of the tape (i.e. 0 wt% as opposed to 10 wt% filler in the tape substrate) would clearly be expected by one of ordinary skill when significantly changing the amount of filler present. The Examiner further notes that Ishikawa et al teaches at Col 4, lines 66-68, that the amount of filler added to the tape will be determined by the "use of the adhesive tape", with large amounts of filler being present in view of such reasons as reducing cost, increasing the opacity (see, e.g. Col 6, line 45 of Ishikawa et al which Example discussed at that point uses no filler for reasons such as to enhance transparency), and increasing the tearability, which appears to be the major "unexpected property" of the Declaration. The Examiner thus concludes that the Declaration appears to clearly fail to rebut the *prima facie* case of record.

Applicants provide the following in response to the Examiner's statements.

First, Applicants note that the Examiner's statement regarding the Declaration of Mr. Ukei as a co-inventor and interested party is no particularly relevant. The Declaration provides factual data which is what the Examiner should consider.

Because the Examiner asserts that Applicants have ignored the “Example 2, Comparative Example 3” showing in Ishikawa, Applicants provide the following explanation. The “Example 2, Comparative Example 3” showing in Ishikawa is a mixture of polyethylene resin (1) having a density of  $0.96 \text{ g/cm}^3$  and polyethylene resin (2) having a density of  $0.96 \text{ g/cm}^3$ . That is, a mixture of polyethylene resins having the same density was used for preparing the base film for the adhesive tape. Thus, the base film of Ishikawa is apparently different in its constitution from the supporting substrate of the invention of the present application, which is prepared by essentially mixing a high-density polyethylene and a low-density polyethylene having a density equal to or less than  $0.919 \text{ g/cm}^3$ . Accordingly, the “Example 2, Comparative Example 3” showing in Ishikawa is not particularly relevant to the claimed invention.

In the present invention, as described above, because specific amounts of specific polyethylenes having different densities are mixed and a specific amount or less of filler is used to prepare the supporting substrate for the pressure-sensitive tape, the effects particular to the invention of the present application can be realized. That is, a general technique to improve the hand cutting properties of an adhesive tape is to add a filler such as calcium carbonate to a plastic film in a ratio of not less than 10 parts by weight per 100 parts by weight of a resin constituting the plastic film, as also described in Ishikawa. However, in the invention of the present application, it is required that a filler is compounded in amounts as small as possible in the plastic film from the viewpoint of controlling brittle fracture at low temperatures, and at the same time, the particular resin composition is used from the viewpoint of satisfying hand cutting properties. Under the circumstances, the invention of the present application cannot be

suggested from Ishikawa which describes only using a large amount of the filler in order to satisfy hand cutting properties.


In view of the above, the present invention is not rendered obvious by Ishikawa. Accordingly, Applicants respectfully request withdrawal of the rejection.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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